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November 5, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Xue et al.  
Application No. 10/007,973  
Filed November 13, 2001

Art Unit 1745  
Examiner J. Maples

Pre-Graphitic Carbonaceous Insertion Compounds and Use as Anodes in  
Rechargeable Batteries

(Attorney Docket No. P22,561-A USA)

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Peter J. Buten III

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Reply to Requirement for Restriction Dated October 5, 2004

Sir:

In response to the Examiner's Action mailed October 5, 2004, applicants traverse hereby the Examiner's Requirement for Restriction set forth therein and request respectfully reconsideration and withdrawal of the Requirement.

The Examiner has required restriction between the following groups of claims:

Group I. - Claim 20, which is directed to a carbonaceous insertion compound, classified in class 423, subclass 414;

Group II. - Claims 45 - 57, which are directed to a process for preparing a pre-graphitic carbonaceous host, classified in class 423, subclass 414; and

Group III - Claims 61 - 87, which are directed to an electrochemical device, classified in class 429, subclass 231.8.

The Examiner's claim numbers do not reflect the two Preliminary Amendments that have been filed. In the parent application, claim 20 was skipped in the claim numbering, and the Examiner required claims 21 - 70 to be renumbered as claims 20 - 69. In the present application, the original specification was re-filed accompanied by a Preliminary Amendment in which claims 1 - 19, 21 - 44, 58 - 60 and 70 were cancelled. In a second Preliminary Amendment, Claims 45 - 57 and 61 - 69 were re-numbered as 44 - 56 and 60 - 68. Claims 71 - 78 were added to replace Claims 58 - 60 and 70, without multiple dependencies. Thus, the pending claims should be 44 - 56, 60 - 68 and 71 - 88.

The basis for the Examiner's Requirement for Restriction is that he considers the claim groups to be distinct in that the process of claim Group II can be used to make other and materially different products than the products of claim Groups I/III, and the products of claim Groups I/III can be made by a process other than that of claim Group II.

It is submitted respectfully that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires that the involved inventions be not only distinct, but also independent. Clearly, the inventions defined in the claims of Groups I. and II. are not independent in that the Group I/III. claims define a product prepared by the process defined in the Group II. claims.

The Examiner has recognized apparently that the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

It is submitted further that the Examiner's Requirement should be withdrawn because it is believed that a proper search of the subject matter of either the Group I/III claims or the Group II. claims requires that a search be conducted for the subject matter of all three groups of claims. This is because the subject matter of the claims is so interrelated. For example, the Group II claims are directed to a method for preparing a pre-graphitic carbonaceous host, which includes the carbonaceous insertion compound defined in the Group I. claim, which is used in the electrochemical device of the Group III claims.

As requested by the Examiner, applicants elect provisionally with traverse to prosecute the process claims of Group II., which the Examiner lists as Claims 45 - 57, and which in the most recent preliminary amendment are listed as Claims 44 - 56. Applicants request respectfully that, upon indication of allowable subject matter with regard to the elected claims, the withdrawn process claims which include all the recitations of the composition claims be rejoined for examination of patentability (M.P.E.P. Section 821.04). Such claims include Claims 60 - 68 and 84 - 88 (as listed in the most recent Preliminary Amendment). It is unclear how these claims correspond to the Examiner's claim numbering because the Examiner only lists claims 61 - 87 in claim Group III.

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It is believed that the claims in this application are in condition for allowance. A favorable action on the merits is respectfully requested. If there are any additional charges in connection with this amendment, the Examiner is authorized to charge Applicant's Deposit Account No. 19-5425 therefor.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter J. Butch III", written over a horizontal line.

Peter J. Butch III, Esq.  
Registration No. 32,203

Synnestvedt & Lechner LLP  
2600 Aramark Tower  
1101 Market Street  
Philadelphia, PA 19107-2950  
Telephone: 215-923-4466  
Facsimile: 215-923-2189

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